TRANSMITTAL OF APPEAL BRIEF	Docket No. 283108004US

In re Application of: Nowitz et al.			
Application No. 10/625,141-Conf. #8283	Filing Date July 23, 2003	Examiner L. Black	Group Art Unit 2163

Invention: METHOD AND SYSTEM FOR RULE BASED INDEXING OF MULTIPLE DATA STRUCTURES

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_____   Dated: April 30, 2007
Judy M. Kadoura
Attorney Reg. No. :   59,833
PERKINS COIE LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Nowitz et al.

Application No.: 10/625,141   Confirmation No.: 8283

Filed: July 23, 2003   Art Unit: 2163

For: METHOD AND SYSTEM FOR RULE   Examiner: L. Black
      BASED INDEXING OF MULTIPLE DATA
      STRUCTURES

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on April 9, 2007, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

I.	Real Party In Interest
II	Related Appeals and Interferences
III.	Status of Claims
IV.	Status of Amendments
V.	Summary of Claimed Subject Matter
VI.	Grounds of Rejection to be Reviewed on Appeal

I.   REAL PARTY IN INTEREST

The rights of the inventors in this application were originally assigned to Thomson Licensing S.A., of Boulogne Billancourt, France, as recorded at reel 014113, frame 0038. Thomson Licensing S.A. subsequently assigned its rights in this application to America Online, Inc., of Dulles, Virginia, as recorded at reel 015804, frame 0813.

II.   RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

Neither Appellant, Appellants' legal representative, nor the above-identified Assignee are aware of other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

III.   STATUS OF CLAIMS

Claims 1-53 have be presented. Claims 1-27 and 53 have been canceled. Claims 28-52 are therefore presently pending and stand finally rejected.

Claims 28-52 are the subject of the present appeal. The text of these claims is set forth below in the Claims Appendix.

IV.   STATUS OF AMENDMENTS

On January 16, 2007, Appellants filed an amendment amending claim 28. In an Advisory Action mailed March 7, 2007, the Examiner indicated that the January 16 amendment would not be entered for purposes of the present appeal. Accordingly, the claims enclosed herein as Appendix A do not incorporate the amendment to claim 28 as indicated in the paper filed on January 16, 2007.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

Each independent claim being appealed is paraphrased below, with citations to the corresponding portions of the specification and drawings as required by 37 C.F.R. § 41.37(c)(1)(v).   These citations are provided in order to illustrate specific examples and embodiments of the recited claim language, and are not intended to limit the claims.

A.   Overview of the Invention

The rejected independent claims are directed to improving search results by automatically categorizing and attributing metadata to media entities in a data store based on their proximity in a map of the data store to media entities that have metadata attributed to them. (*See e.g.,* Specification, pars. 0023, 0032-0036, 0038-0039, 0040-0044, Figures 2-5). For example, as illustrated in Figure 2 of Appellants' specification, an operator may manually attribute the metadata category "showbiz" to media entity 214, which is located in the fourth level of the data store. Based upon the proximity of media entity 218 and media entity 214 in a map of the data store, Appellants' technology automatically attributes metadata to media entity 218 indicating that it belongs to the category "showbiz." With Appellants' technology, users can designate areas that span multiple categories and are not limited to attributing metadata in a particular direction through the hierarchy without any regard for proximity.

B.   Independent Claims on Appeal

1.   Claim 28

Claim 28 is directed to a method for associating metadata with a media entity (*See e.g.,* Specification, pars. 0008, 0034, 0036, 0038) by identifying a first media entity located within a data store (*See e.g., Id.,* pars. 0020, 0032-0034; Figure 2); receiving user input that identifies the first media entity as belonging to a distinguished category (*See e.g., Id.,* pars. 0037-0039); receiving user input designating a portion of a map of the data store containing the first media entity as corresponding to the distinguished category (*See e.g.,*

Id., pars. 0021, 0030-0031, 0035, 0038-0041; Figure 2); attributing metadata to the first media entity indicating that it belongs to the distinguished category (*See e.g., Id.*, pars. 0023, 0038, 0040, 0043-0044; Figure 3); automatically identifying a second media entity located within the designated portion of the map (*See e.g., Id.*, pars. 0030, 0033, 0035, 0040-0044); and based upon the location of the second media entity within the designated portion of the map, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category (*See e.g., Id.*, pars. 0038-0039, 0040-0044).

2.   Claim 40

Claim 40 is directed to a computer-readable medium whose contents cause a computing system to perform a method of associating metadata with a media entity (*See e.g.,* Specification, pars. 0008, 0034, 0036, 0038) by identifying a first media entity located within a data store (*See e.g., Id.*, pars. 0020, 0032-0034; Figure 2); receiving user input that identifies the first media entity as belonging to a distinguished category (*See e.g., Id.*, pars. 0037-0039); receiving user input designating a portion of a map of the data store containing the first media entity as corresponding to the distinguished category (*See e.g., Id.*, pars. 0021, 0030-0031, 0035, 0038-0041; Figure 2); attributing metadata to the first media entity indicating that it belongs to the distinguished category (*See e.g., Id.*, pars. 0023, 0038, 0040, 0043-0044; Figure 3); automatically identifying a second media entity within the data store belonging to the distinguished category (*See e.g., Id.*, pars. 0030, 0033, 0035, 0040-0044); and based upon belonging to the category, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category (*See e.g., Id.*, pars. 0038-0039, 0040-0044).

3.   Claim 52

Claim 52 is directed to a computer memory containing a data structure for associating metadata with a media entity (*See e.g.,* Specification, pars. 0008, 0034, 0036, 0038) comprising: a category identifying one or more media entities (*See e.g., Id.*, par. 0030); metadata that applies to each media entity in the category (*See e.g., Id.*, par. 0034;

Figure 3); one or more rules for automatically identifying a media entity belonging to the category based on user input designating a portion of a map of the data store containing the media entity as corresponding to the category (*See e.g., Id.*, pars. 0021, 0030-0031, 0035-0044; Figure 2), such that the contents of the data structure may be used to automatically associate the metadata with identified media entities belonging to the category (*See e.g., Id.*, pars. 0038-0039, 0040-0044).

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   The Examiner's Rejections

The Examiner rejected claims 28-52 under 35 U.S.C. § 103(a) over a combination of Perkes (U.S. Pub. No. 2003/0110503) and Omoigui (U.S. Pub. No. 2003/0126136).

B.   The Issues on Appeal

Is the rejection of claims 28-52 under 35 U.S.C. § 103(a) over a combination of Perkes and Omoigui proper?

VII.   ARGUMENT

A.   The rejection of claims 28-52 under 35 U.S.C. § 103(a) over a combination of Perkes and Omoigui is improper

1.   Legal Requirements for Obviousness

35 U.S.C. § 103(a) provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

To properly reject claims as being obvious, "the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d (BNA) 1955, 1956 (Fed. Cir. 1993). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *Id.* (quoting *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d (BNA) 1529, 1531 (Fed. Cir. 1993)). The Examiner is not allowed to use hindsight gleaned from the invention itself to modify references. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51 (Fed. Cir. 1988). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Although a prior art device "may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Federal Circuit emphasized this point by stating that:

> [a]lthough a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.

In re Chu, 66 F.3d 262, 298 (Fed. Cir. 1995).

Under these standards, Appellants' invention would not have been obvious. The Examiner has not identified prior art references that disclose all the elements of pending claims 28-52. Moreover, the required motivation to combine the cited references is not present, and instead the references teach away from their combination. Therefore, the present rejection should be reversed.

2.   Overview of the Cited Reference

a.   Perkes

Perkes describes a media-on-demand framework that collects pre-categorized media of different types for presentation to a user. (Perkes, pars. 0012, 0061). As a user interacts with the Perkes system, information regarding the user's usage is collected to profile the user's perceived interests. (Perkes, pars. 0043-0045). "The collected information can include the type of digital media the consumer views or listens to (Internet, movies, video, music, DVD, CD, TV/HDTV, etc.) and details about that digital material (i.e., genre, title, run time, artist, etc.)..." (Perkes, par. 0036). The information collected...is categorized according to the content types referred to above." (Perkes, par. 0044). For example, there may be a predefined category for sports and a predefined subcategory for baseball that contains videos from baseball games. Perkes explains that "content items may be part of multiple categories" as the system "processes the [collected] information and compares it to one or more databases of content grouped in similar categories and classifications" (*Id.*). For example, the Perkes system "obtains logs on the websites visited by the consumer, whereby the metatags obtained from those web sites are collected to obtain information regarding the types of websites (e.g., sports, entertainment) the user prefers." (Perkes, par. 0040). The collected information may be used to further refine the profile of the consumer "to the point where the consumer will be delivered more specific content." (*Id.*).

b.   Omoigui

Omoigui describes an "intelligent, learning web" that uses "semantic data" to improve data retrieval. (Omoigui, pars. 0344, 0526). For example, a user may search a database containing music files for "all country songs that are duets." The system would know to retrieve songs performed by two artists and which artists perform country music.

3.   <u>The Examiner has failed to make a prima facie case of obviousness</u>

In a Final Office Action mailed November 13, 2006, the Examiner rejected claims 28-52 under 35 U.S.C. § 103(a) over a combination of Perkes and Omoigui. However, the Examiner has failed to show how the references teach or suggest the elements recited by claims 28-52. More specifically, the Examiner has failed to show how the combination of Perkes and Omoigui teach or suggest (1) "designating a portion of a map of [a] data store containing [a] first media entity as corresponding to [a] distinguished category;" (2) "attributing metadata to the first media entity indicating that it belongs to the distinguished category;" and (3) "based upon [a] location of [a] second media entity within the designated portion of the map, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category."

a.   <u>The Examiner has failed to show how the combination of Perkes and Omoigui teach or suggest "designating a portion of a map of [a] data store containing [a] first media entity as corresponding to [a] distinguished category"</u>

The Examiner characterizes Perkes' discussion at paragraphs 0044–0045, 0063–0067, and 0152 as "designating a portion of a map of [a] data store containing [a] first media entity as corresponding to [a] distinguished category." (Office Action, November 13, 2006, p. 3). The Examiner is mistaken. The sections relied upon by the Examiner are directed to receiving input from a user for selecting a display format for the program guide. The Perkes system includes multiple display formats that a user may select (Perkes, par. 65) and customize (e.g., by adding or subtracting displayed categories). (Perkes, par. 66). For example, the user may select a display format that displays all movies first (*Id.*) instead of the default display format, which displays all media in the order of the user's perceived level of interest. (Perkes, par. 65). Clearly, Perkes' selection of a display format does not teach or suggest "<u>designating</u> a portion of a map of [a] data store...as corresponding to [a] distinguished category."

Moreover, the program guide is not a map of a data store. Rather, it is merely reflective of the selected display format. Perkes explains that a program guide provides information from one or more media sources about: "media being presented to the user, media available for presenting to the user, and/or the order in which media objects can be combined and simultaneously presented to the user." (Perkes, par. 0014). Significantly, the program guide described by Perkins organizes media objects "without having to make the distinction of where the media objects are stored—locally, digitally, optically, on a distant server, in a TV broadcast, etc." (Perkes, par. 0258). In contrast, a data store map provides information used to define levels and sublevels of a located data store as a hierarchical structure (*See e.g.*, Specification p. 13). In other words, the recited data store map provides the structural information that is specifically withheld by Perkes' program guide.

The Examiner responded to Appellants' argument that Perkes does not teach or suggest "designating a portion of a map of [a] data store...as corresponding to [a] distinguished category" with the following statement:

> "Perkes disclose 'receiving user input designating a portion of a map of a data store...as corresponding to a distinguished category' at pars. 0013-0014 (program guide), 0030-0032, 0045, 00268."

(Office Action, November 13, 2006, p. 8).

These cited sections also fail to teach or suggest "receiving user input designating a portion of a map of [a] data store...as corresponding to [a] distinguished category." For example, at paragraph 0045 Perkes describes profiling a user of a media on demand system to more accurately select content that meets the user's perceived interests. When a user interacts with the Perkes system (e.g., views a video), metadata associated with the media object (e.g., genre, actors, etc.) is collected and processed. To generate the program guide, Perkes explains that "media objects are filtered by metadata and presented in navigable arrays." (Perkes, par. 0268). That is, Perkes generates the

program guide by filtering from a set of pre-categorized media objects only those objects having categories consistent with user input reflecting the user's interests. This type of user input—whether navigating the guide, selecting media, or selecting a display format—does not teach or suggest "<u>designating</u> a portion of a map of [a] data store...as corresponding to [a] distinguished category" as recited by the claims.

> b. <u>The Examiner has failed to show how the combination of Perkes and Omoigui teach or suggest "attributing metadata to the first media entity indicating that it belongs to the distinguished category"</u>

The Examiner characterizes Perkes' discussion at paragraphs 0012-0014, 0043-0045, 0228, and 0264 as providing "attributing metadata to the first media entity indicating that it belongs to the distinguished category." The Examiner is mistaken. When a user interacts with the Perkes system (e.g., downloads a song), metadata associated with the media object is collected to profile the user's perceived interests and select content satisfying those interests. (Perkes, pars. 0043-0045). Perkes describes three techniques to select content for delivery to a user. In each technique, metadata associated with the user-selected content is collected and processed. For example, Perkes describes a technique in which "metatags obtained from those websites [visited by the user] are collected to obtain information regarding the types of websites (e.g., sports, entertainment) the user prefers." (Perkes, par. 0040). Another technique logs the user's "music listening habits" by "[u]sing metatags associated with digital music files..." to profile the types of music the user prefers. (*Id.*). Also, Perkes describes a technique which logs the user's television viewing habits "by obtaining information obtained from the television signal itself or in combination with a TV-program database..." to profile the types of television the user prefers. (*Id.*). Because Perkes merely uses associated metadata earlier attributed to media objects to categorize them, the Perkes system fails to teach or suggest "attributing metadata to the first media entity indicating that it belongs to the distinguished category."

The Examiner responded to Appellants' argument that Perkes neither teaches nor suggests "attributing metadata to the first media entity indicating that it belongs to the distinguished category" with the following statement:

> "Perkes teaches in paragraphs 0012, 0228, that 'each media object comprises information relating to a media type and metadata descriptor. A set of metadata descriptors is defined based on at least a portion of the media objects. An interface is presented to a user through which information is organized based on the set of metadata descriptors.' Paragraph 0045 describes the categorization of different data types, and the continuous refinement of for categories and sub-categories based on the content of the documents; metadata and classifications – pars. 0043-0045, 0082, 0247, 0286."

(Office Action, November 13, 2006, pp. 7-8).

The Examiner argues that organizing media objects based on the objects' associated metadata is the same as attributing metadata to a media entity. The Examiner is mistaken. Perkes does not teach or suggest attributing metadata to a media entity indicating that it belongs to the distinguished category. Rather, Perkes describes collecting and processing the metadata already associated with of media objects with which the user interacts.

Moreover, refinement of these categories is simply a method of filtering media objects to better select content that meets the perceived interests of the user. As discussed above, when a user interacts with the Perkes system, information regarding the user's usage is collected to profile the user's perceived interests. (Perkes, pars. 0043-0045). "The collected information can include the type of digital media the consumer views or listens to (Internet, movies, video, music, DVD, CD, TV/HDTV, etc.) and details about that digital material (i.e., genre, title, run time, artist, etc.)..." (Perkes, par. 0036). The information collected...is categorized according to the content types referred to above." (Perkes, par. 0044). Perkes explains that the collected information is "compare[d] to one or more databases of content grouped in similar categories and classifications." (*Id.*). For example, a video category may be refined to include a genre category (e.g., romantic

comedies), if the system perceives that the user is interested a particular genre of videos based on the metadata of the media objects viewed by the user. Thus, refinement of a category is merely an indication that the system has collected information suggesting a perceived interest of the user, and does not relate to attributing metadata to a media entity indicating that it belongs to a distinguished category.

        c.   The Examiner has failed to show how the combination of Perkes and Omoigui teach or suggest "based upon [a] location of [a] second media entity within the designated portion of the map, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category"

Appellants cannot find a teaching or suggestion in Perkes that describes "automatically attributing metadata to [a] second media entity indicating that it belongs to [a] distinguished category [based upon the location of the second media entity within the designated portion of the map]." The Examiner relies on Omoigui for disclosure of "how objects are categorized and utilized." (Office Action, November 13, 2006, p. 3). However, Omoigui describes, with little detail, three methods of media object categorization. Omoigui describes media objects "inherit[ing] all predicates from the root type." (Omoigui, par. 0579). The inheritance method described by Omoigui attributes multiple types to one object. For example, when a type is attributed to a particular media object, any types that are ancestors of that type are also attributed to the object. In contrast, Appellants' technology provides "automatically attributing metadata to [a] second media entity indicating that it belongs to [a] distinguished category [based upon the location of the second media entity within the designated portion of the map]." With Appellants' technology, users can designate areas that span multiple subcategories and are not limited to attributing metadata vertically—and particularly in a downward direction through the hierarchy—without any regard for proximity.

In addition to categorizing objects using inheritance, Omoigui describes using "XML Web Service Calls" or a "categorization engine." (Omoigui, pars. 0681, 0706). Omoigui, however, does not explain how these services categorize objects. Omoigui describes a

Web Service as "representing black-box functionality that can be reused without worrying about how the service is implemented." (Omoigui, par. 0313). A categorization engine "take[s] a piece of text or XML...and returns the categories...that the text or XML belong to, along with categorization scores. Omoigui does not provide an example of how to implement a Web Service or categorization engine.

Omoigui also describes an "inference engine," which uses ongoing activity and "probabilistic inferences" to categorize objects. (Omoigui, pars. 0622-0628). Omoigui contains no indication that the inference engine allows a user to "designat[e] a portion of a map of [a] data store" and "automatically attribute[e] metadata to [a] second media entity [based upon the location of the second media entity within the designated portion of the map]."

For at least these reasons, it is clear that Perkes and Omoigui together fail to teach or suggest all of the elements recited by claims 28-52, and are therefore incapable of supporting any proper rejection under 35 U.S.C. § 103(a). Because the Examiner has failed to identify prior art references that disclose the elements recited by claims 28-52, the rejection of these claims should be reversed.

4.   Perkes and Omoigui together fail to teach or suggest all of the
      elements recited by claims 28-52, and are therefore incapable of
      supporting any rejection under 35 U.S.C. § 103(a)

Together, Perkes and Omoigui fail to teach or suggest all of the elements recited by claims 28-39, which recite:

> "...designating a portion of a map of [a] data store containing [a] first media entity as corresponding to [a] distinguished category; attributing metadata to the first media entity indicating that it belongs to the distinguished category...and based upon the location of [a] second media entity within the designated portion of the map, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category."

That is, Appellants' technology automatically attributes metadata to a media entity in a data store based on its proximity in a designated portion of a map of the data store to a media entity that has metadata manually attributed to it. Neither Perkes nor Omoigui teach or suggest this approach. Perkes does not discuss designating a portion of a map of a data store as corresponding to a distinguished category, nor does Perkes discuss attributing metadata to media entities. Omoigui discusses media objects inheriting all predicates from the root type as a way of categorizing media objects in a hierarchical schema, but does not discuss designating a portion of a map of a data store or automatically attributing metadata to a media entity based on its proximity within the designated portion of the map to a media entity that has metadata manually attributed to it. For this reason, Perkes and Omoigui together fail to teach or suggest all of the elements recited by claims 28-39, and therefore the rejection of these claims should be reversed.

Also, Perkes and Omoigui together fail to teach or suggest all of the elements recited by claims 40-51, which recite:

> "...designating a portion of a map of the data store containing the first media entity as corresponding to the distinguished category; attributing metadata to the first media entity indicating that it belongs to the distinguished category...and based upon belonging to the category, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category."

That is, Appellants' technology automatically attributes metadata to a media entity based on it belonging to the category corresponding to a designated portion of a map of the data store containing a media entity that has metadata manually attributed to it. Neither Perkes nor Omoigui teach or suggest this approach. Perkes does not discuss designating a portion of a map of a data store as corresponding to a distinguished category, nor does Perkes discuss attributing metadata to media entities. Omoigui discusses media objects inheriting all predicates from the root type as a way of categorizing media objects in a hierarchical schema, but does not discuss designating a portion of a map of a data store or automatically attributing metadata to a media entity based on it belonging to the category corresponding to a designated portion of a the map containing a media entity that has

metadata manually attributed to it. For this reason, Perkes and Omoigui together fail to teach or suggest all of the elements recited by claims 40-51, and therefore the rejection of these claims should be reversed.

In addition, Perkes and Omoigui together fail to teach or suggest all of the element recited by claim 52, which recites:

> "A computer memory containing a data structure...comprising...one or more rules for automatically identifying a media entity belonging to [a] category based on user input designating a portion of a map of the data store containing the media entity as corresponding to the category, such that the contents of the data structure may be used to automatically associate the metadata with identified media entities belonging to the category."

That is, Appellants' technology designates a portion of a map of a data store as corresponding to a distinguished category and automatically attributes metadata to media entities based on their belonging to the category corresponding to the designated portion of the map. Neither Perkes nor Omoigui teach or suggest this approach. Perkes does not discuss designating a portion of a map of a data store as corresponding to a distinguished category, nor does Perkes discuss attributing metadata to media entities. Omoigui discusses media objects inheriting all predicates from the root type as a way of categorizing media objects in a hierarchical schema, but does not discuss designating a portion of a map of a data store as corresponding to a category or automatically attributing metadata to media entities based on their belonging to the category corresponding to the designated portion of the map. For this reason, Perkes and Omoigui together fail to teach or suggest all of the elements recited by claim 52, and therefore the rejection of this claim should be reversed.

5.   Perkes and Omoigui teach away from their combination, and are
     therefore incapable of supporting any proper rejection under 35 U.S.C.
     § 103(a)

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Perkes and Omoigui teach away from their combination. Perkes describes a technique that "evaluates the consumer's perceived preferences and, using predictive models, determines content types that might be of interest to the consumer." (Perkes, par. 0047). Omoigui discredits Perkes' method of selecting content to be delivered to the user. Specifically, Omoigui characterizes the technique described by Perkes as "index-driven rather than context-driven," i.e., "techniques [that] rely on historical user search trends to make basic assumptions as to desired information...[or] rely on categorization of Web sites to further focus the search results to areas anticipated to be most relevant." (Omoigui, par. 0009). According to Omoigui, such techniques result in "continued ambiguity and inefficiency." (*Id.*). Because Perkes and Omoigui teach away from their combination, they are incapable of supporting any proper rejection under 35 U.S.C. § 103(a), and the rejection of these claims should be reversed.

6.   There is no apparent motivation to combine Perkes and Omoigui, and
     therefore their combination is incapable of supporting any proper
     rejection under 35 U.S.C. § 103(a)

Even if Perkes and Omoigui can be combined, the potential combination is not sufficient to establish a *prima facie* case of obviousness. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (MPEP § 2143.01(III); emphasis in original). This requirement, which demands that there be some teaching, suggestion, or motivation to combine the references, protects against the use of impermissible hindsight reasoning. "Defining the problem in terms of its solution reveals

improper hindsight in the selection of the prior art relevant to obviousness." In re Kahn, Fed. Cir. 2006 (quoting Ecolochem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1372 (Fed. Cir. 2000) (quoting Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed. Cir. 1998))). Accordingly, the motivation to combine prior art references must be based upon specific teaching in the prior art, such as a specific suggestion in the prior art reference.

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> The *teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, not in applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). MPEP § 2143 (emphasis added).

The required motivation to combine Perkes and Omoigui is not present. The Examiner indicates that one skilled in the art would have been motivated to combine Omoigui with Perkes "to periodically categorize objects in searchable data storages in order to help users search for certain subjects quicker and thus, better search results." Office Action, November 13, 2006, p. 3). However, Appellants cannot find a teaching or suggestion to combine Perkes and Omoigui. Instead, the motivation provided by the Examiner appears to be based solely on the alleged beneficial results that would be produced by combing the references in accordance with Appellants' claims, without identifying any motivation from the prior art that supports the combination as is required. Because the Examiner's statements do not satisfy the Examiner's burden, the rejection of these claims should be reversed.
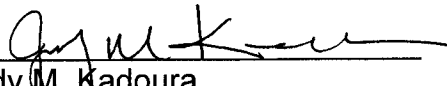
B.   Summary

Each of claims 28-52 has been improperly rejected both (1) in that the Examiner has failed to provide prior art references that disclose all of the elements of these claims, and (2) in that the cited references would not support any rejection of these claims. Accordingly, Appellants seek the reversal of the rejection of claims 28-52.

VIII.   CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do not include the amendment filed on January 16, 2007.

Dated: 4/30/07   Respectfully submitted,

By _____
Judy M. Kadoura
    Registration No.: 59,883
PERKINS COIE LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000
(206) 359-7198 (Fax)
Attorney for Applicant

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/625,141

28.   A method in a computing system of associating metadata with a media entity comprising:

identifying a first media entity located within a data store;

receiving user input that identifies the first media entity as belonging to a distinguished category;

receiving user input designating a portion of a map of the data store containing the first media entity as corresponding to the distinguished category;

attributing metadata to the first media entity indicating that it belongs to the distinguished category;

automatically identifying a second media entity located within the designated portion of the map; and

based upon the location of the second media entity within the designated portion of the map, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category.

29.   The method of claim 28 wherein identifying the first and second media entities includes crawling a web site.

30.   The method of claim 28 further comprising selecting the distinguished category by examining a path of a URI at which the first media entity is identified.

31.   The method of claim 28 further comprising selecting the distinguished category by examining a web site name at which the first media entity is identified.

32.   The method of claim 28 wherein attributing metadata includes parsing a file name of the first or second media entity.

33.   The method of claim 32 further comprising using a metadata dictionary to store a first string in the metadata when a second string is identified in the file name.

34.   The method of claim 28 wherein attributing metadata includes prompting an operator to enter metadata based upon the distinguished category.

35.   The method of claim 28 wherein attributing metadata includes extracting metadata from the first media entity.

36.   The method of claim 28 further comprising comparing the specified metadata with known good metadata.

37.   The method of claim 28 further comprising checking the validity of the identified media entities.

38.   The method of claim 28 wherein the media entities are selected from the group consisting of text, audio, video, and images.

39.   The method of claim 28 wherein the metadata conforms to one or more of a Dublin Core standard, an MPEG standard, or an XML standard.

40.   A computer-readable medium whose contents cause a computing system to perform a method of associating metadata with a media entity, the method comprising:

identifying a first media entity located within a data store;

receiving user input that identifies the first media entity as belonging to a distinguished category;

receiving user input designating a portion of a map of the data store containing the first media entity as corresponding to the distinguished category;

attributing metadata to the first media entity indicating that it belongs to the distinguished category;

automatically identifying a second media entity within the data store belonging to the distinguished category; and

based upon belonging to the category, automatically attributing metadata to the second media entity indicating that it belongs to the distinguished category.

41.   The method of claim 40 wherein identifying the first and second media entities includes crawling a web site.

42.   The method of claim 40 further comprising selecting the distinguished category by examining a path of a URI at which the first media entity is identified.

43.   The method of claim 40 further comprising selecting the distinguished category by examining a web site name at which the first media entity is identified.

44.   The method of claim 40 wherein attributing metadata includes parsing a file name of the first or second media entity.

45.   The method of claim 44 further comprising using a metadata dictionary to store a first string in the metadata when a second string is identified in the file name.

46.   The method of claim 40 wherein attributing metadata includes prompting an operator to enter metadata based upon the distinguished category.

47.   The method of claim 40 wherein attributing metadata includes extracting metadata from the first media entity.

48.   The method of claim 40 further comprising comparing the specified metadata with known good metadata.

49.   The method of claim 40 further comprising checking the validity of the identified media entities.

50.   The method of claim 40 wherein the media entities are selected from the group consisting of text, audio, video, and images.

51.   The method of claim 40 wherein the metadata conforms to one or more of a Dublin Core standard, an MPEG standard, or an XML standard.

52.   A computer memory containing a data structure for associating metadata with a media entity comprising:

a category identifying one or more media entities;

metadata that applies to each media entity in the category;

one or more rules for automatically identifying a media entity belonging to the category based on user input designating a portion of a map of the data store containing the media entity as corresponding to the category,

such that the contents of the data structure may be used to automatically associate the metadata with identified media entities belonging to the category.

APPENDIX B

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.